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PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
PSTM0010/MRK

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on May 31, 2006

Signature

Typed or printed

name Alexandra AllisonApplication Number
09/685,078Filed
10/6/2000First Named Inventor
David Allison BennettArt Unit
3629Examiner
Webb, Jamisue A.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 45744☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34. _____

Signature

Marilyn R. Khorsandi
Typed or printed name(626) 796-2856
Telephone numberMay 31, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of _____ forms are submitted.

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Alexandra Allison
Alexandra Allison

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : David Allison Bennett, et al.
Application No. : 09/685,078
Filed : October 6, 2000
Title : APPARATUS, SYSTEMS AND METHODS FOR ONLINE,
MULTI-CARRIER, MULTI-SERVICE PARCEL SHIPPING MANAGEMENT FEATURING
NOTIFICATION SERVICE OPTION COMPARISON FOR MULTIPLE CARRIERS
Grp./Div. : 3629
Examiner : Webb, Jamisue A.
Docket No. : PSTM0010/MRK

PRE-APPEAL BRIEF REQUEST FOR REVIEW REASONS

Mail Stop AF 140 S. Lake Ave., Suite 312
Commissioner for Patents Pasadena, CA 91101-4710
P.O. Box 1450 May 31, 2006
Alexandria, VA 22313-1450
Commissioner:

In the Office Action, a Final rejection, Claims 1-6, 49-52 and 58 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nicholls et al. (U.S. Patent No. 5,485,369; "Nicholls") in view of Fisher et al. (U.S. Patent No. 6,047,264; "Fisher"), Kara et al. (U.S. Patent No. 6,233,568; "Kara") and Thiel (U.S. Patent No. 5,699,258; "Thiel"). Claims 28-33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nicholls in view of Pauly et al. (U.S. Patent No. 4,958,280; "Pauly"), Kara and Thiel. Claims 1-6, 28-33, 49-52 and 58 may sometimes be referred to herein collectively, as the "rejected Claims".

After carefully considering the rejections, this Request is filed pursuant to the guidelines for requesting a pre-appeal brief conference as presented in the Official Gazette (the "OG"), dated July 12, 2005. A pre-appeal brief panel review of the rejection of the rejected Claims is respectfully requested on grounds described in more detail below with reference to the Claims of the present application as amended in the Amendment and Response filed in response to the Office Action dated August 1, 2005 (the "Amendment and Response"). This Request is timely filed within the three-month period set by the Examiner because it is filed before the expiration of June 3, 2006. Reconsideration and allowance of the application in view of this Request is respectfully requested.

A. NO MPEP §706.02(i) PRIMA FACIE MOTIVATION TO COMBINE FISHER OR PAULY

It is respectfully asserted that there is no teaching or suggestion, and that the rejections did not identify any teaching or suggestion, found in the prior art, as required under MPEP

§706.02(j), to combine Fisher or Pauly with the other cited references. *See also* MPEP §2143.

Fisher discloses a merchant system that tracks shipment status of customer orders sent by a particular merchant to each respective ordering customer, and that composes and sends email notices to particular customers regarding the status of their respective orders. Fisher email notices are composed and sent according to the results of an interrogation by the Fisher system of respective carrier systems to determine the shipping status of the respective order by the respective carrier. Fisher, col. 2, lines 12 – 18.

As compared to the carrier-system-interrogation/system-email-generation disclosure of Fisher, it is respectfully submitted that the rejected claims, such as, for example, Claim 1, are not directed or related to a system that *generates or otherwise provides* email notifications. Rather, as compared to the carrier-system-interrogation/system-email-generation disclosure of Fisher, Claim 1, for example is directed to "... receive ... a request input by a user for an electronic mail delivery notification service by a carrier system for shipping a particular parcel and an input by the user of parcel specifications for the particular parcel; and for each respective carrier of a plurality of carriers that would provide electronic mail delivery notification for shipping the particular parcel according to the request, display ... a simultaneous identification of charges for each delivery service offered by the respective carrier according to the parcel shipping specifications...". That is, Claim 1 is directed to displaying charges for each delivery service offered by each respective carrier of a plurality of carriers that would provide electronic mail delivery notification for shipping the particular parcel.

It is respectfully submitted that generating and/or providing electronic mail delivery notification as disclosed in Fisher does not provide any teaching or suggestion, as required by MPEP §§706.02(j), to combine Fisher with the other cited references with respect to the above-cited limitations of *e.g.*, Claim 1 of the present application. Therefore, it is respectfully asserted that Fisher is not properly combined with the other cited references and that, therefore, the Claims of the present application should be allowed.

Further, as compared to Pauly, Claim 28 is directed to:

... for each respective carrier of a plurality of carriers that would provide verbal delivery notification for shipping the particular parcel ... display ... a simultaneous identification of charges for each delivery service offered by the respective carrier according to the parcel shipping specifications.

As compared to the above-cited limitations of Claim 28, "Paul[]y discloses the use of

[customer] service representatives which provide verbal communication of delivery status (Column 9, lines 34-38)." Office Action, Topic No. 16, p. 5. It is respectfully submitted that providing verbal communication of delivery status as disclosed in Pauly does not provide any teaching or suggestion, as required by MPEP §§706.02(j), to combine Pauly with the other cited references with respect to the above-cited limitations of, e.g., Claim 28. Therefore, it is respectfully asserted that Pauly is not properly combined with the other cited references and that, therefore, the Claims of the present application should be allowed.

B. NO SHOWING UNDER MPEP §2143 FOR EACH LIMITATION OF EACH CLAIM

Even assuming for the sake of argument that Fisher and Pauly were properly combined with the other cited references, it is respectfully asserted that the rejections did not indicate, as required under MPEP §2143, how the cited references, even when combined, disclose, anticipate, teach or suggest each of the limitations of each of the rejected Claims.

As compared to, for example, the above-cited limitations of Claim 1, as previously explained above, Fisher discloses generating and sending email notifications to purchasers, but does not disclose displaying rates by delivery services provided by carriers.

Further, as compared to, e.g., the above-cited limitations of Claim 28, as previously explained above, "Paul[]y discloses the use of [customer] service representatives which provide verbal communication of delivery status (Column 9, lines 34-38)..." (Office Action, Topic No. 16, p. 5), but does not disclose displaying rates by delivery services provided by carriers.

Yet further, as compared to, for example, the above-cited limitations of Claims 1 and 28, as explained further below, Nicholls, Kara and Thiel, all disclose a user first pre-selecting: in Nicholls, a transit time requirement; in Kara, a service type; and in Thiel, a type of shipment.

As compared to, for example, the above-cited limitations of Claims 1 and 28, Nicholls does not disclose any display of, much less a simultaneous display of, charges for each delivery service offered by [a] respective carrier according to the parcel shipping specifications. Nicholls describes its FIG. 4A as showing that:

[T]he Shipments client accepts user input for the routing, rating and documentation of a group of packages comprising a shipment... the service is selected from the Service box. Alternatively, the service may be set to Best Way and the system will choose the least cost carrier which meets the transit time requirements indicated in the commitment field.

Nicholls, col. 7, lines 52-61. That is, a user of the Nicholls system must input (pre-select), in the "commitment field", a transit time requirement (such as, e.g., overnight, or 2-day -- i.e., an input

similar to a delivery service) before the Nicholls system will calculate any rates. Then, depending on whether the user has input "Best Way", or has input a particular carrier in the Service box, when the user clicks the "Rate" icon, the Nicholls system will calculate a rate for the given user input. There is no disclosure in Nicholls that the Nicholls system will display more than a single rate responsive to the given user input. *See also, Office Action*, Topic No. 17, Page 5 ("Nicholls discloses the automatic selection of a carrier and fails to disclose displaying the rates of the carriers to the user.").

Still further, for the reasons explained in more detail in the Amendment and Response, as compared to, e.g., the above-cited limitations of Claims 1 and 28, it is respectfully asserted that Kara does not disclose a "... simultaneous identification of charges for each delivery service offered by the respective carrier according to the parcel shipping specifications ...", "... for each respective carrier of a plurality of carriers that would provide delivery notification services [such as electronic mail delivery notification (Claim 1) or verbal delivery notification (Claim 28)] for shipping the particular parcel according to the request for delivery notification services...". As compared to, e.g., the above-cited limitations of e.g., Claims 1 and 28, in Kara, the "program automatically calculates the fees for each shipping service provider offering service commensurate with the desired shipping and/or delivery parameters." Kara, col. 22, lines 39 – 42. That is, according to Kara, once the user indicates a service type to the Kara system, the Kara program calculates the rates for each carrier that supports service type previously indicated by the user; only one rate per carrier is calculated.

Similarly, it is respectfully submitted that Thiel does not disclose displaying or identifying shipping costs for each delivery service of each carrier. Thiel discloses a system, method and device for franking postal matter (applying postage to mail). Similar to Kara, Thiel discloses a comparison and display of shipping costs (e.g., Thiel, col. 6, lines 53-55) by multiple carriers based on a user first selecting a type of shipment (express, air, priority, general, etc.) (e.g., Thiel, col. 8, lines 58-66). Thiel explains that the stored Thiel table cited by the Office Action (at Col. 11, lines 1-13 in Office Action Topic No. 10, p. 4) is used to perform a mask search *after* the user has already "defined the required services." Thiel, col. 11, lines 15-23.

For reasons similar to those given above with respect to Claims 1 and 28, it is respectfully submitted that none of the cited references, whether considered alone or in combination with any other reference(s) of record, disclose, anticipate, teach or suggest all of the

limitations recited by independent Claims 49, 50 and 51, which do not require a user-pre-selection of a delivery service. For example, Claim 49 recites "... for each respective carrier of a plurality of carriers ... display[ing] ... *a simultaneous identification of each delivery service* offered by the respective carrier according to the parcel shipping specifications." (Emphasis added) As another example, Claim 50 recites "... calculat[ing] a service-specific, carrier-specific delivery notification service charge by *each delivery service* offered by *each* respective carrier ... for each delivery notification service option" (Emphasis added).

Further still, for reasons similar to those described above, it is respectfully asserted that, none of the cited references, whether considered alone, or in combination, anticipate, disclose, teach or suggest the following limitations recited by independent Claim 58:

- (1) identifying, from a plurality of carriers, a first carrier that would offer an electronic mail delivery notification service in conjunction with performing said at least one delivery service, and
- (2) identifying, from said plurality of carriers, a second carrier that would offer an electronic mail delivery notification service in conjunction with performing said at least one delivery service ...

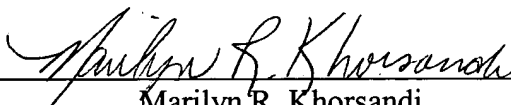
For the foregoing reasons, because independent Claims 1, 28, 49-52, and 58, are patentable over the cited references, it is respectfully asserted that dependent Claims 2 through 6, and 29 through 33, are therefore also patentable over the cited references.

C. CONCLUSION

For the foregoing reasons, it is respectfully submitted that the invention disclosed and claimed in the present application is not fairly taught by any of the references of record, taken either alone or in combination, and that the application is in condition for allowance. Accordingly, reconsideration and allowance of the application is respectfully requested.

Respectfully submitted,

KHORSANDI PATENT LAW GROUP, ALC

By 

Marilyn R. Khorsandi
Reg. No. 45,744
626/796-2856